

REMARKS

Introduction

Claims 11-15 and 21-30 stand objected to under 35 U.S.C. § 132 ("Section 132") for introducing new matter into the disclosure of the invention. Claims 11, 13-15 and 21-23 stand rejected under 35 U.S.C. § 102(b) ("Section 102") as anticipated by U.S. Pat. No. 6,172,328 ("Jones"). Claims 12 and 24-30 stand rejected under 35 U.S.C. § 103(a) ("Section 103") as unpatentable over Jones. Claims 11-30 stand rejected under Section 103 as obvious in view of U.S. Pat. No. 5,305,550 ("Skonecki") and further in view of Jones. Accordingly, Applicant provides the following remarks:

Features of an apparatus may be recited either structurally or functionally. MPEP § 2114. However, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *Id.* Even if the prior art performs all the functions recited in the claims, the prior art cannot anticipate the claims if there is any structural difference. *Id.*

While some aspects of the present invention have been discussed both structurally and functionally, the claims are structurally distinguishable from the prior art. For example, the structure of the ink overlaid on a group of flowers of the present invention is "identical." This is not true of Skonecki's ink which is handwritten and "unique." See Skonecki, Column 1, lines 32-33. In addition, the rose of the present invention is different. Applicant's rose is "free of indentations and surface cellular damage," whereas the rose of Skonecki is indented, causing surface cellular damage and faster withering. These differences are not merely process-related differences but are differences in the roses themselves.

Other applicants have successfully used both structural and functional language. For example, U.S. Patent No. 6,070,724 ("McCool") claims:

A package for housing a product which moves during operation, the package comprising:

a first holographic image generating layer affixed to a surface of the package, said first holographic image generating layer producing first and second images which simulate a first type of movement that is produced by the product during its use, the first and second images being viewable from first and second angles, respectively;

a second holographic image generating layer overlaid on the first holographic image generating layer, said second holographic image generating layer producing third and fourth images which simulate a second type of movement that is produced by the product during its use, the third and fourth images being viewable from third and fourth angles, said second holographic image generating layer being transparent so that the first and second images, which are produced by the first holographic image generating layer, are visible through the second holographic image generating layer;

wherein the package is formed of an opaque material, and has a printed image on the surface of the package illustrating the product which is concealed within the package, and wherein the first and second holographic image generating layers are disposed on a part of the printed image.

Accordingly, Applicant respectfully submits in light of the preceding remarks and the remarks that follow that the claims of the present invention have been structurally distinguished from the prior art and that the claims of the present invention are in condition for allowance.

Claim Objections under 35 U.S.C. § 132.

Claims 11-15 and 21-30 stand objected to under Section 132 for introducing new matter into the disclosure of the invention.

Applicant respectfully submits that the pending claims do not present new matter as each limitation finds support in the application as filed. A flower on which an image has been “pad - printed” finds support beginning at page 8, ln. 21 where a mechanical press is disclosed that creates a negative of an image on a pad, where the pad swivels to facilitate transfer of the image onto an organic product. See Specification, p. 9, ln. 9. A mechanical press is further disclosed in Figures 1 and 2 originally filed. Finally, “wherein each of the group of flowers is in a natural configuration” finds support in Figures 3 and 5 of the originally filed application.

In addition, amended claim 11 now recites a group of flowers. These are shown in original figure 5 and do not present new matter.

In light of the foregoing, Applicant respectfully requests withdrawal of the objections to the pending claims under Section 132.

Claim Rejections under 35 U.S.C. § 102.

Claims 11, 13-15 and 21-23 stand rejected under Section 102 as anticipated by Jones. An invention is unpatentable under Section 102 if “the invention was . . . in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.” A Section 102 rejection is only appropriate, however, where the “reference fully discloses in every detail the subject matter of a claim.” *Application of Foster*, 383 U.S. 966 (1966). For the reasons set forth below, Applicant submits that the reference cited by the Examiner does not teach each and every element of the claimed invention, as amended, and thus does not bar the claimed invention as a public use of the invention more than one year prior to the date of application.

Claim 11, as amended, recites “a group of flowers each having had placed thereon an overlaid identical pad-printed image, wherein each of the group of flowers is in a natural configuration free of indentations and surface cellular damage.”

Jones, on the other hand, teaches methods for etching, cutting and /or altering the surface of a flower, plant, cut foliage, or foliage incorporated into consumable products such as cigars . . . with computer controlled laser energy to effect a desired artistic or utility design or marking on the foliage. See Jones Abstract. As Jones neither discloses nor suggests overlaying an image onto a group of flowers in a natural configuration, Jones fails to anticipate the present invention.

Indeed, the laser energy technology taught by Jones results in altering and/or removing

material from the subject flower, plant or foliage to effect the appearance of a message or other design therein. The repeatable image claimed by the present invention, on the other hand, removes and/or alters no material at all. Rather, a desired image is overlaid onto a surface of the flower so as to preserve its compositional integrity. Thus, the process that results in the present product is an additive process in contrast to the subtractive process taught by Jones, which results in a different product.

As Jones fails to teach overlaying an image onto an organic product as taught by the present invention, Jones fails to anticipate the present invention as claimed in claim 11.

As claims 13-15 and 21-23 add further limitations to otherwise allowable subject matter, such claims are also not anticipated by Jones.

Accordingly, Applicant respectfully requests withdrawal of rejections of claims 11, 13-15 and 21-23 under Section 102.

Claim Rejections under 35 U.S.C. § 103 as being unpatentable over Jones.

Claims 12 and 24-30 stand rejected under Section 103 as unpatentable over Jones. An invention is unpatentable under Section 103 “if the differences between the subject matter sought to be patented over the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.”

To establish a *prima facie* case of obviousness, three criteria must be met. “First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP

§ 2142.

Claim 11, as amended, recites “a group of flowers each having had placed thereon an overlaid identical pad-printed image, wherein each of the group of flowers is in a natural configuration free of indentations and surface cellular damage.” Claim 24, as amended, recites “a flower petal on which a repeatable image has been overlaid, wherein the petal is detached from the flower.” Applicant finds no mention or suggestion of these elements in Jones, nor any equivalent thereof. As discussed above with reference to Section 102, Jones teaches methods for etching, cutting and /or altering the surface of a flower, plant, cut foliage, or foliage incorporate into consumable products such as cigars . . . with computer controlled laser energy to effect a desired artistic or utility design or marking on the foliage. See Jones Abstract. As Jones teaches using laser technology to remove material from an organic product to effectuate the appearance of a message or design, Jones fails to disclose or suggest implementing a device to overlay an image onto a flower in an additive process. In fact, Jones teaches away from the present invention by emphasizing the use of laser technology which, by nature, effectuates a material change in the composition of an organic product by etching, cutting or thermally altering its properties. The present invention, on the other hand, allows an organic product to remain entirely intact by virtue of the additive printing overlay process disclosed and claimed therein.

As the cited reference fails to teach or suggest using a device to overlay an image onto a flower, the cited reference fails to render the present invention obvious. Further, as the cited reference teaches away from a device to implement an additive printing process on an organic product, the present invention is particularly non-obvious in light of such reference.

Accordingly, Applicant respectfully requests withdrawal of the rejections of claims 12

and 24-30 under Section 103 as being unpatentable over Jones.

Claim Rejections under 35 U.S.C. § 103 as being unpatentable over Skonecki in view of Jones.

Claims 11-30 stand rejected under Section 103 as obvious in view of Skonecki and further in view of Jones. As stated above, an invention is unpatentable under Section 103 “if the differences between the subject matter sought to be patented over the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.” To establish a *prima facie* case of obviousness, three criteria must be met. “First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP § 2142.

In addition, under Section 103, the scope and content of the prior art are to be determined; the differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. MPEP § 2141.

A comparison of Skonecki and the present invention shows important differences. Skonecki teaches that a message or drawing may be applied by an applicator, such as a pen containing an opaque pigmented oil-based paint, to a fresh natural flower. See Skonecki Abstract. Using a pointed applicator such as a pen places a variable amount of pressure on the flower causing indentation, cellular damage and faster withering. In contrast, the present invention discloses using a pad or roller as a transfer medium. See Specification, page 9, lines 21-22. The larger surface area of the pad or roller places less force per square inch on the flower.

As a result, the flower is not indented.

Because the cellular surface of the present invention has not been compromised, the flower lasts longer. This is an important advantage since the principal purpose of a flower is to have a pleasant appearance, since a flower is a highly perishable product and since many flowers are imported from foreign countries.

Whereas Skonecki discloses a unique, individualized message (see Skonecki, Column 1, lines 32-33), the present invention discloses an identical or repeatable image (See Claims 11, 24). Because the preparation of the repeatable image of the present invention takes place prior to application onto the flower, more sophisticated designs are possible. In addition, since the present invention's images are repeatable, identical duplication is possible. In contrast, identical duplication is never possible with a hand-written design. The present invention's repeatable images can also be more quickly produced than hand-written images, especially with more sophisticated designs.

In Skonecki, all of the applicators are operable to enable the paint to flow from a tip onto the petal. See Skonecki, Column 2, lines 14-16. Because the present invention discloses an image that has been "overlaid" onto the petal by using a pad or roller, the ink thickness will be more uniform than where the ink flows onto the petal, especially where the flow of ink is controlled by the pressure applied to the tip.

In addition, because the design is overlaid, there is less chance of smudging. When hand-drawn, as in Skonecki, the artist will sometimes smudge the first portion of the design in his or her preparation of the latter portions of the design.

Applicant respectfully submits that none of the references, alone or in any combination,

which have been cited by the Examiner, teach or suggest the limitations discussed above. In particular, one skilled in the art of handwriting art would not think to combine the computer controlled laser energy teachings of Jones. Accordingly, Applicant respectfully submits for at least these reasons the cited references do not make obvious claims 11-30.

Secondary Considerations of Non-Obviousness

Under Section 103, objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. MPEP § 2141. To be pertinent to the issue of nonobviousness, the commercial success of devices falling within the claims of the patent must flow from the functions and advantages disclosed or inherent in the description in the specification. MPEP § 716.03(b). Also, the commercial success must be due to claimed features, and not due to unclaimed features. MPEP § 716.03(a).

Although the present invention is not obvious as discussed above, secondary considerations are presented as further evidence of nonobviousness. Applicant has had considerable commercial success and success in finding partners for licensing agreements. The considerable success in finding partners for licensing agreements shows the commercial success of embodiments of the present invention flows from the functions and advantages disclosed in the description in the specification and that the commercial success is due to the claimed features, otherwise, licensing agreements would not be necessary. The following are examples of this success and are supported by the attached declaration.

Licensing

Applicant has entered into a licensing contract with Taylor Corporation, which is the largest wedding card printing company in the nation with over 87% of the nation's wedding card printing business.

Applicant has also licensed its product to GiftTree (gifttree.com), a large corporate and public web site who features and sells Applicant's product on a daily basis.

FTD.com also licensed Applicant's product several months ago and features and sells Applicant's product as well. Discussions are currently under way to formally license all 22,000 of FTD's licensed retail florists. On September 15-17, 2003, Applicant trained all twenty of the FTD in-house sales individuals who will begin the formal individual licensing of their 22,000 stores under the Master License Agreement with FTD.

USA Bouquet, based in Miami, Florida has also licensed Applicant's product. USA Bouquet has offices in Atlanta and Chicago for the fulfillment of current orders. Each of these facilities has Applicant's printing and engraving equipment on site. These three facilities fulfill all orders placed anywhere in the Continental United States for next day delivery.

Chicago-based Kennecott Brothers has also licensed Applicant's product. Kennecott Brothers services 1800 retail establishments as well as several large Super Floral groups like Jewel Osco/Albertsons. Kennecott Brothers has licensed Applicant's equipment, both the printers and the engravers. Applicant is currently setting up 2200 stores under the license agreement with Albertsons through the Kennecott Brothers fulfillment center in Chicago. Under separate and individual license agreements, Albertsons is planning to open 200 stores in September, 200 stores in each of October, November, and December and 1400 stores in the month of January.

In addition, Applicant has licensed over 80 individual retail shops around the nation with the capacity to print flowers on their own premises.

Also, Sam's Club, a division of Wal-Mart Corp., the largest retail corporation in the world, has licensed Applicant's product, initially going out to their Scent Express base of 30 million corporate customers.

Applicant has entered into an agreement with Publix's 850 retail outlets to begin immediately enrolling and training each of their individual stores.

Applicant is currently concluding agreement discussions with Golden Rose, the largest rose distributor in Canada, to make them a licensed distributor for the entire country of Canada.

The Zuriel group in Holland has agreed to represent Applicant in the twenty-two European countries they currently service. They have 167 refrigerated trucks that are going daily to a larger market than the entire United States floral market.

The Regent Hotel in Anaheim, California has also licensed Applicant's product. Regent Hotel is a large hotel group that is beginning to introduce Applicant's product to their 700 sister five-star hotels around the world to be used for special events.

The largest wholesalers in the nation have been approved to license Applicant's product, including Delaware Valley in the Northeast, Denver Floral Wholesale in the Northwest and through Colorado, and Mellano, who services Southern California and all of Nevada.

Additionally, Applicant has individual contracts with various other stores and corporations and is beginning to license individual "event planners" around the nation who represent the large corporate events and large wedding planners who have need on special occasion for large quantities of flowers that are personalized and customized for specific use.

Applicant's considerable success in finding partners for licensing agreements shows the commercial success of embodiments of the present invention flows from the functions and advantages disclosed in the description in the specification and that the commercial success is due to the claimed features, otherwise it would not have been necessary for the many organizations listed above to enter into licensing agreements with Applicant.

Commercial Success

Applicant's licensing agreement with FTD.com currently generates sales of approximately seventy dozen flowers a day. A substantial increase in sales is expected once discussions are completed, formally licensing all 22,000 of FTD's licensed retail florists.

Regent Hotel has started using Applicant's product at some of its large events, such as a \$100,000 event it holds twice a week.

In addition, Applicant has developed an extensive sales and marketing network. This network includes: Taylor Corporation, the United States market share leader in wedding cards; Giftfree.com, a large corporate and public web site that sells Applicant's products on a daily basis; USA Bouquet, who sells and delivers Applicant's products nationally; Kennecott Brother's 1800 retail establishments and its large Super Floral groups including Jewel Osco/Albertsons, that will be selling Applicant's products in 2200 stores by January, 2004; 80 individual retail shops; Sam's Club, exposing Applicant's product to 30 million corporate customers; Publix's 850 retail outlets; Golden Rose, the largest rose distributor in Canada; the Zuriel group in Holland, who services twenty-two European countries; the largest wholesalers in the United States, including Delaware Valley in the Northeast, Denver Floral Wholesale in the Northwest and through Colorado, and Mellano, who services Southern California and all of Nevada; and

other individual planners of large corporate events and weddings.

Applicant's considerable success in establishing its extensive sales and marketing network by finding partners for licensing agreements shows the commercial success of embodiments of the present invention flows from the functions and advantages disclosed in the description in the specification and that the commercial success is due to the claimed features, otherwise it would not have been necessary for the many organizations listed above to enter into licensing agreements with Applicant.

Long-Felt Need

The present invention also solves the long-felt need for a repeatable, rapid method for laying a design onto a flower that preserves the integrity of the flower. Evidence of this long-felt need is found in Skonecki, which documents this need dating back to 1993. See Skonecki, Column 2, lines 16-18. Applicant's success in licensing its product further shows this long-felt need was not solved by Skonecki and shows that Applicant's product solves this long-felt need.

In conclusion, the differences between Skonecki and the present invention are substantial. These differences, together with Applicant's commercial success, many licensing agreements and solution to a long-felt need show the present invention is non-obvious.

Accordingly, Applicant respectfully requests withdrawal of the rejections of claims 11-30 under Section 103 as being unpatentable over Skonecki in view of Jones.

Conclusion

Based on the foregoing, Applicant believes that the claims of the present invention are in


condition for allowance and respectfully requests the same.

Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to initiate a telephone interview with undersigned counsel.

DATED this 25 day of September, 2003.

Respectfully submitted,

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